

Remarks

Claims 1-45 are pending. Claim 1 is amended.

The Examiner rejected Claims 1-45 under 35 U.S.C. § 112, first paragraph, for failing to provide support for the recited “processor.” As amended, Claim 1 now recites “one or more search engines” in place of the processor. Applicant’s Specification provides support, for example, at page 4, lines 19-25:

According to one embodiment of the present invention, illustrated by the block diagram of FIG. 1, affinity portal 100 provides eMail and online community services. As shown in FIG. 1, affinity portal 100 is organized around a subscriber profile database 102 and electronic addresses directory 103, and search capability provided by one or more scalable, real-time parametric search engines, which can perform low-level search on the databases and on the world wide web (WWW) of the Internet. These engines provide a platform to build a number of services that are discussed in further detail below.

Accordingly, Applicant submits that Claims 1-45 fully comply with 35 U.S.C. § 112, first paragraph.

The Examiner rejected Claims 1-45 under 35 U.S.C. § 101 for being directed to non-statutory subject matter. In this rejection, the Examiner gave no weight to the recited “processor,” stating that Applicant’s Specification does not provide support. As discussed above, with respect to the Examiner’s rejection of these claims under 35 U.S.C. § 112, first paragraph, Applicant’s Specification provides express support for the currently recited “search engines.” Thus, Claims 1-45 comply with 35 U.S.C. § 101.

Withdrawal of the Examiner’s rejections under 35 U.S.C. §§ 112 and 101, reconsideration and allowance of Claims 1-45 are therefore requested.

The Examiner rejected Claims 1-10 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 20060041505 ("Enyart"), in view of U.S. Patent Application Publication 20070083438 ("Coleman"), and further in view of "what was well-known in the networking art". With respect to independent Claim 1, the Examiner states:

The Examiner notes that there is no patentable weight given to the *processor for operating the transaction service* because there is no support in the Applicant Specification regarding said processor.

Enyart disclosed (re. Claim 1) a system comprising: a subscriber profile database including electronic addresses (Enyart-Paragraph 21, '*database includes a registry of possible message recipients*') and biographical and affinity information of subscribers to the system (Enyart-Paragraph 1006, '*opt in to receive paid email messages from vendors*'); and a electronic address directory for retrieving from the subscriber profile database electronic addresses of selected subscribers. (Enyart-Paragraph 66, '*select list of recipients*')

While Enyart substantially disclosed the invention, Enyart did not explicitly disclose (re. Claim 1) *a transaction tracking service which tracks responses to each subscriber's registration messages.*

While Enyart substantially disclosed the invention, Enyart did not explicitly disclose (re. Claim 1) selecting subscribers based on a search criterion selecting a specified biographical or affinity profile.

The Examiner notes that at the time of the invention email systems implementing permission-based direct email marketing was well-known in the networking art. (See Lanzillo US 2002/0032602). Furthermore the use of search criterion for selecting targeted recipients was also well-known in the networking art. Furthermore the use of databases and search/retrieval facilities were well-known in the networking art. (See Weitzman US Publication 2002/0099605)

The methods for matching potential buyers with targeted advertisements were well-known in the art. (See Coleman US Publication 20070083438).

The Examiner notes that in permission-based email

exchanges where a receiver obvious for a sender to specify a search criterion for selecting users with indicated preferences.

Coleman disclosed (re. Claim 1) a transaction tracking service which tracks responses to each subscriber's registration messages. (Coleman-Figure 8, Paragraph 97-100)

Furthermore Coleman disclosed (re. Claim 1) selecting subscribers based on a search criterion selecting a specified biographical or affinity profile. (Coleman- Paragraph 20-21 ,Paragraph 58, 'advertisements may be presented to only certain potential purchasers who meet requirements set by the advertiser')

Enyart and Coleman are analogous art because they present concepts and practices regarding email systems implementing permission-based direct email marketing. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Coleman into Enyart. The motivation for said combination would have been to enable aggregating a pool of purchasers for linking to sellers. (Coleman-Paragraph 9)

Applicant respectfully traverses the Examiner's rejection. First, as amended, Claim 1 now recites search engines that operate both an electronic address directory and a transaction tracking service:

1. A system comprising:

a subscriber profile database including electronic addresses and biographical and affinity information of subscribers to the system;

a transaction tracking service which tracks each subscriber's registration messages; and

one or more search engines which operate the transaction tracking service and an electronic address directory; wherein, in response to a query of the electronic address directory, the search engines retrieve from the subscriber profile database electronic addresses of selected subscribers based on a search criterion selecting a specified biographical or affinity profile.

As discussed above, the search engines are supported by Applicant's Specification. Thus, the Examiner is requested to reconsider the rejection to give weight to the supported

“search engines” limitations.

Second, neither Enyart nor Coleman discloses or suggests using search engines to operate a transaction tracking service and an electronic address directory.

Third, Applicant submits that the Examiner is mistaken in stating that Coleman’s Figure 8 and paragraphs 97-100 disclose Applicant’s recited “transaction tracking service.” As recited in Claim 1, the transaction tracking service “tracks each subscriber’s registration messages.” As discussed in Applicant’s Specification, at page 10, lines 14-22, tracking such messages allow the system to both avoid mistakenly rejecting messages and to learn the on-line shopping behavior the subscribers, which may be valuable to advertisers. In contrast, Coleman’s Figure 8 and paragraphs 97-100 teaches tracking, rather than registration messages, potential purchasers who have specifically and expressly indicated a purchase interest in a good or service. For example, Coleman’s paragraph 97 states:

[0097] Block 317 of FIG. 8 indicates the act of posting an offer from a seller to the electronic file 11. At this point, a variety of procedures could be followed. In one embodiment, an indication of the offer could be posted in the electronic file 11 and the potential purchasers could be required to post an indication of purchaser interest in that offer to sign up for the deal. In another embodiment, all of the potential purchasers who previously posted an indication of purchase interest in the good or service could be automatically signed up for the deal, which is the embodiment depicted in FIG. 8. In yet another embodiment, all of the potential purchasers who posted an indication of purchase interest in the good or service could be notified of the pending offer by the seller, such as by email.

Thus, Applicant respectfully submits that the Examiner is incorrect in stating that Coleman’s Figure 8 and paragraphs 97-100 teach Claim 1’s “transaction tracking service.”

For at least the reasons stated above, Applicant respectfully submits that Claims 1-10 and 13 are each allowable over the combined teachings of Enyart, Coleman and “what was

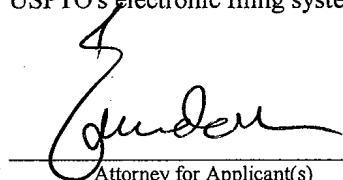
well-known in the networking art.” Reconsideration and allowance of Claims 1-10 and 13 are therefore requested.

The Examiner rejected under 35 U.S.C. § 103(a) (i) Claim 11 as being unpatentable over Enyart, in view of Coleman, further in view of U.S. Patent Application 2006/0229934 (“Law”), and further in view of “what was well-known in the networking art”; (ii) Claim 12 as being unpatentable over Enyart, in view of Coleman, further in view of Law, further in view of U.S. Patent 6,959,324 (“Kubik”), and further in view of “what was well-known in the networking art”; (iii) Claims 14-21, 24-26, 31-33, and 37-45 as being unpatentable over Enyart, in view of Coleman, further in view of U.S. Patent Application Publication 2003/0163485 (“Goodwin”), and further in view of “what was well-known in the networking art”; (iv) Claims 22-23 as being unpatentable over Enyart, in view of Coleman, in view of Goodwin, further in view of U.S. Patent Application Publication 2005/0055321 (“Fratkina”), and further in view of “what was well-known in the networking art”; (v) Claim 34 as being unpatentable over Enyart, in view of Coleman, in view of Goodwin, further in view of U.S. Patent Application Publication 2004/0201625 (“Karamchedu”), and further in view of “what was well-known in the networking art”; (vii) Claims 27-30 as being unpatentable over Enyart, in view of Coleman, in view of Goodwin, further in view of U.S. Patent 7,280,982 (“Moskowitz”), and further in view of “what was well-known in the networking art”; (viii) Claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Enyart, in view of Coleman, in view of Goodwin, further in view of Moskowitz, and further in view of “what was well-known in the networking art”; and (ix) Claim 36 as being unpatentable over Enyart, in view of Coleman, in view of Goodwin, further in view of U.S. Patent Application Publication 2005/0004837 (“Sweeney”), and further in view of “what was well-known in the networking art.”

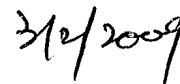
Applicant respectfully traverses the Examiner's rejection. Because Claims 11-12, and 14-45 each depend from Claim 1, Claims 11-12 and 14-45 are each allowable over the combined teachings of Enyart, Coleman and "what was well-known in the networking art" for the reasons set forth above. As the teachings of Law, Kubik, Goodwin, Fratkina, Karamchedu, Moskowitz and Sweeney which the Examiner relied for his rejection do not cure the deficiencies of Enyart, Coleman and "what was well-known in the networking art" (i.e., teach "[tracking] each subscriber's registration message," and "one or more search engines which operate the transaction tracking service and an electronic address directory"), Applicants respectfully submits that Claims 11-12, and 14-45 are each allowable over the combinations of teachings relied on by the Examiner. Accordingly, reconsideration and allowance of Claims 11-12 and 14-45 are therefore requested.

All pending claims (i.e., Claims 1-45) are therefore believed allowable. If the Examiner has any question regarding the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant at (408)-392-9250.

Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's electronic filing system on March 2, 2009.

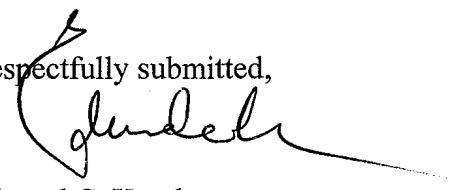


Attorney for Applicant(s)



Date of Signature

Respectfully submitted,


Edward C. Kwok
Attorney for Applicant(s)
Reg. No. 33,938

Law Offices of
Haynes and Boone, LLP
2033 Gateway Place, Suite 400
San Jose, CA 95110
Tel: (408) 392-9250
Fax: (408) 392-9262